Supreme Court, U.S.
FILED
OCT 24 2002
OFFICE OF THE CLERK

No. 02-487

In the Supreme Court of the United States

JOSEPH A. GENTILUOMO,

Petitioner,

v.

BRUNSWICK BOWLING AND BILLIARDS CORPORATION (individually and doing business as Brunswick Technology Ventures and as Quantum),
and
COLUMBIA 300, INC. (individually and doing business as Track, Inc.),
and
PIN BREAKER, INC.,

Respondents.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

BRIEF OF RESPONDENT BRUNSWICK BOWLING AND BILLIARDS CORPORATION IN OPPOSITION

MICHAEL O. WARNECKE
Counsel of Record
DONALD W. RUPERT
WAYNE L. TANG
Mayer, Brown, Rowe & Maw
190 South LaSalle Street
Chicago, IL 60603
(312) 782-0600

Counsel for Respondent Brunswick

11pp

QUESTION PRESENTED

Whether the petition for certiorari should be denied because the Federal Circuit's ruling is not in conflict with any of its or this Court's previous decisions and the Federal Circuit's decision is fact specific and correctly applied the law to reach its finding.

RULE 29.6 STATEMENT

The parent corporation of respondent, BRUNSWICK BOWLING & BILLIARDS CORPORATION (d/b/a BRUNSWICK TECHNOLOGY VENTURES and QUANTUM), is BRUNSWICK CORPORATION which is a publicly held corporation which owns 10 percent or more of respondent's stock

TABLE OF CONTENTS

Page

QUESTION PRESENTED I

RULE 29.6 STATEMENT ii

TABLE OF AUTHORITIES iv

STATEMENT 1

REASONS FOR DENYING THE PETITION 3

I. The Petition Fails To Provide Any Reason To Grant Certiorari 3

II. The Federal Circuit's Decision Is Case Specific 4

III. The Federal Circuit's Decision Correctly Applied Its Law 4

CONCLUSION 6

TABLE OF AUTHORITIES

Page(s)

CASES

Brotherhood of Locomotive Firemen v. Bangor & Aroostook R. Co., 389 U.S. 327 (1967) 4

Haynes v. Jessop Steel, 8 F.3d 1573 (Fed. Cir. 1993) 5

In re Application of Aller, 220 F.2d 454 (C.C.P.A. 1955) 5

In re Geisler, 116 F.3d 1465 (Fed. Cir. 1997) 5

In re Hill, 284 F.2d 955 (C.C.P.A. 1960) 5

In re Huang, 100 F.3d 135 (Fed. Cir. 1996) 5

In re Woodruff, 919 F.2d 1575 (Fed. Cir. 1990) 5

STATUTES

35 U.S.C. § 103 3

Fed. R. Civ. P. 56 3

STATEMENT

Respondent, Brunswick Bowling and Billiards Corporation ("Brunswick"), respectfully submits that this Court should deny the petition for writ of certiorari filed by petitioner Joseph A. Gentiluomo ("Gentiluomo"). The petition seeks review of the Federal Circuit's judgment and opinion in this case, which are found at A29-30 and A11-26, respectively, of the Appendix submitted by Gentiluomo with his petition.

For purposes of this response, Brunswick does not contest the majority of Gentiluomo's statement of facts, but will add a few points omitted from the petition. Despite the hyperbolic rhetoric of the petition, the invention claimed in the patent in suit ("the '614 patent") is simply a bowling ball that has an inner core made from a material having a density that is higher than the density of its outer covering material. The '614 patent postulates that this configuration releases a greater amount of kinetic energy when the ball strikes bowling pins. (Gentiluomo Appendix at A12).

The '614 patent itself is a result of a reissue of a previous patent. Gentiluomo sought the reissue after discovering that a prior art bowling ball (known as the "Randolph ball") also had an inner core material with a density higher than the density of its outer covering. (Gentiluomo Appendix at A13-14). In order to distinguish his purported invention over the Randolph ball, Gentiluomo amended his claims in the reissue proceeding by assigning a density range to the inner core material that was different from the density of the core in the Randolph ball. (Gentiluomo Appendix at A14). This amendment resulted in the '614 patent. The Randolph prior art ball was relied on by both the District Court and the Federal Circuit in support of their independent findings that three of the claims of the '614 patent, asserted against Brunswick and the other defendants, were obvious and thus invalid.

In order to obtain the reissue '614 patent, Gentiluomo filed a declaration with the U.S. Patent and Trademark Office (the "PTO") in which he conceded that the prior art Randolph ball anticipated many of the claim elements he now contends are not obvious. As Brunswick demonstrated to the Federal Circuit, the only substantive difference between the elements that Gentiluomo conceded were anticipated by the prior art and the patent claims at issue here was the range of density values. Gentiluomo's attempts to reargue the issues he conceded in his PTO declaration were correctly ignored by both the District Court and the Federal Circuit. Gentiluomo's petition is silent on these points.

The petition also fails to describe the procedural posture of the case. The Federal Circuit's decision reveals that of the four claims of the '614 patent at issue, the Federal Circuit affirmed summary judgment of invalidity as to three of them, but reversed the District Court as to one claim. (Gentiluomo Appendix at A26). The Federal Circuit thus remanded the case to the District Court for further consideration of this last claim. (Gentiluomo Appendix at A30).

In view of these matters, Brunswick respectfully submits that there is no reason to grant the petition. Gentiluomo has failed to meet any of the applicable criteria for granting certiorari; the Federal Circuit's decision represents no conflict of law between the Circuits or with this Court's case law. In fact, the only issues Gentiluomo raises are based on alleged errors in interpreting facts and misapplication of correctly stated law, which are matters that normally are not grounds for granting certiorari petitions. In addition, given the remand from the Federal Circuit to the District Court, the petition essentially seeks interlocutory review from this Court. Finally, on the merits of the petition, Brunswick submits that both the District Court and the unanimous Federal Circuit were correct in concluding that as a matter of law the three claims of the '614 patent were obvious in view of the Randolph ball.

REASONS FOR DENYING THE PETITION

I. THE PETITION FAILS TO PROVIDE ANY REASON TO GRANT CERTIORARI

Supreme Court Rule 10 provides the framework for granting a petition of certiorari. There is no reason under any of the Rule 10 factors to grant Gentiluomo's petition. *First*, there is no conflict between the courts of appeals or the state high courts on the patent law issues in this case. Indeed, Gentiluomo has not identified any conflict presented by the decision in this case measured against the Federal Circuit's decisional law on the obviousness inquiry. *Second*, there is obviously no conflict between a state court of last resort and any federal court on any federal patent question presented here. *Third*, the decision below is not in conflict with this Court's past decisions on obviousness and patent validity and Gentiluomo has pointed to none.

Both the District Court and the Federal Circuit correctly noted and applied the summary judgment standards set forth in Fed. R. Civ. P. 56 and the law relating to obviousness, based on 35 U.S.C. § 103, in finding that the claims of the '614 patent were invalid. (Gentiluomo Appendix at A18-19). In essence, Gentiluomo's petition rests on his belief that the Federal Circuit was in error because: (i) the Court did not interpret the facts correctly by not giving due weight to Gentiluomo's expert affidavit; and (ii) the Court misapplied the summary judgment law and obviousness law. Significantly, however, Gentiluomo does not contend that the Federal Circuit relied on incorrect law or failed to state properly the law upon which the decision was based. Under these circumstances, Gentiluomo's petition merely evidences his disagreement with the ultimate holding of the Federal Circuit. This is not a reason for granting the petition.

A final factor in favor of denying the petition under Rule 10 is the fact that the Federal Circuit's decision has not con-

cluded the case. Because the Federal Circuit reversed the District Court's decision on one of the claims, the case has been remanded to the District Court. The lack of finality in the judgment is sufficient alone to deny the petition. *Brotherhood of Locomotive Firemen v. Bangor & Aroostook R. Co.*, 389 U.S. 327, 328 (1967).

II. THE FEDERAL CIRCUIT'S DECISION IS CASE SPECIFIC

A further reason to deny the petition flows from the fact that the Federal Circuit's decision is a case specific holding that will have no impact on future matters. Indeed, the Federal Circuit's unanimous opinion was marked as "not citable as precedent", pursuant to Federal Circuit Rule 47.6. (Gentiluomo Appendix at A11). A fact bound case, such as this, does not warrant granting the petition.

III. THE FEDERAL CIRCUIT'S DECISION CORRECTLY APPLIED ITS LAW

As he did before the Federal Circuit, here Gentiluomo is trying to manufacture a dispute by retracting the positions he previously took before the PTO, as stated in his PTO declaration. The elements of the claims at issue, that he now contends are non-obvious, were admitted by him in his PTO declaration as being found in and anticipated by the prior art Randolph ball. For example, the majority of the petition argues that the Federal Circuit ignored expert testimony purportedly supporting the proposition that a heavier weight core which decreases moment of inertia would be non-obvious. However, Gentiluomo ignores the finding of the Federal Circuit that even taking into account such unsupported expert testimony, the facts could not be reasonably interpreted in Gentiluomo's favor because such limitations were not in the claim language and he stated in his own PTO reissue declaration that the exact claim language was anticipated by the Randolph ball. (Gentiluomo Appendix at A21). Signifi-

cantly, Gentiluomo has consistently failed to come to grips with his prior declaration, both in the Federal Circuit and in his petition here.

The only difference between the claims at issue and Randolph ball was a range of values for the inner core and the outer covering materials which Gentiluomo added during the reissue proceeding to distinguish over the Randolph ball. The Federal Circuit found the claims invalid based on Brunswick's clear and convincing evidence, including admissions made by Gentiluomo and expert testimony, that it would be obvious given one set of values known from the Randolph ball to simply extend that set of values to the claimed range of values. (Gentiluomo Appendix at A24).

To attempt to save his patent, Gentiluomo was required to show that his claimed range of values was critical to his invention and thus produced some unexpected result which differed from the result obtained for values outside of that range. This approach flows from past cases, such as *In re Geisler*, 116 F.3d 1465, 1467 (Fed. Cir. 1997), and *In re Woodruff*, 919 F.2d 1575, 1578 (Fed. Cir. 1990), where the values of the prior art overlapped those of the claim at issues, as well as other cases such as *In re Huang*, 100 F.3d 135, 136 (Fed. Cir. 1996); *Haynes v. Jessop Steel*, 8 F.3d 1573, 1577 (Fed. Cir. 1993); *In re Hill*, 284 F.2d 955, 958 (C.C.P.A. 1960); *In re Application of Aller*, 220 F.2d 454 (C.C.P.A. 1955), where the values of the prior art did not overlap those of the claim. In all of these cases, the patent holder was required to demonstrate that the claimed values had some critical significance in order to overcome a finding of obviousness. The Federal Circuit correctly applied this established law in finding the three claims were obvious because Gentiluomo provided no evidence showing that the range of values he selected for the claims in the '614 patent had any significance or produced any unexpected results. (Gentiluomo Appendix at A24). In fact, Gentiluomo's deposition testimony and answers to written discovery conceded

that there was no special significance to the selected ranges other than to bring the claims outside the scope of the Randolph ball. (Gentiluomo Appendix at A67).

CONCLUSION

For the foregoing reasons, the petition for certiorari should be denied.

Respectfully submitted.

MICHAEL O. WARNECKE
DONALD W. RUPERT
WAYNE L. TANG
Mayer, Brown, Rowe & Maw
190 South LaSalle Street
Chicago, IL 60603
(312) 782-0600

Counsel for Respondent

OCTOBER 2002